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In the Supreme Court of the United States

OCTOBER TERM, 1949.

No. .....

THE MIDLAND STEEL PRODUCTS COMPANY,
Petitioner,

vs.

CLARK EQUIPMENT COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

To the Honorable Fred M. Vinson, Chief Justice of the United States Supreme Court and Associate Justices of the Supreme Court of the United States:

Your Petitioner, The Midland Steel Products Company, respectfully prays for a Writ of Certiorari to the Circuit Court of Appeals for the Sixth Circuit to review the judgment of that Court entered May 31, 1949 (Supplemental Transcript of Record and Proceedings in United States Court of Appeals—Sixth Circuit at page 41) in a suit for alleged infringement of four patents (rehearing denied July 25, 1949) affirming the judgment of the District Court, for the Western District of Michigan, Southern Division (Vol. I, p. 87; 75 F. S. 143), and directing that the Complaint (Vol. I, pp. 1-6) be dismissed.

A transcript of the record in the cause, including the proceedings of said Circuit Court of Appeals, has been furnished in accordance with the rules of this Court.

(A) Summary Statements of Matters Involved:

This cause is a patent infringement cause involving four patents relating to thick tube welding.* The District Court held that the Respondent was estopped to deny validity of the patents and this holding was not disturbed by the Court of Appeals.

Both Courts held non-infringement with respect to each of the four patents. Although the drawings, Figs. A, B, C and D hereof, illustrate only a single feature of the invention, of the patents and of the claims involved, that feature will serve to illustrate the specific law questions upon which this Petition is based.

Figs. A and B show a seam to be welded which is open for its full depth, i.e., from the top 1a to the bottom 2a. Figs. C and D show a seam which is open at the top 1c, but closed at the bottom 4c, and hence open for less than the full depth. Figs. A and B represent a preferred form of the inventor of the patents in suit. Figs. C and D show the form which the Courts concluded the defendant (respondent here) employed.

The edges of the seam are molten and a fusion weld is effected by bringing the edges together under pressure. In the preferred form the edges may be molten for the full depth of the seam as shown in Figs. A and B hereof and as is illustrated in Fig. 15 of Patent 1,948,801 (Vol. III, p. 912) or, as stated in Patent 1,948,801, they may "not be actually melted for their full depth" (Cl. 1, col. 1, ll. 33-

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* For many uses thick walled tubes must be "worked," i.e., expanded, contracted, and otherwise mauled to make such articles as banjo axle housings (Vol. III, p. 914). Unless the characteristics of the tube were uniform it would crack, spread too thin, or otherwise be defective in parts. Prior to the inventions of the patents in suit "seamless tube" was used; this was made by punching a tube out of a billet, an expensive and laborious proceeding. Many efforts and failures had been made to weld a seam tube which would be as good as the "seamless tubes." That result was finally achieved by the inventions of the patents in suit and has been accepted and used as a solution.

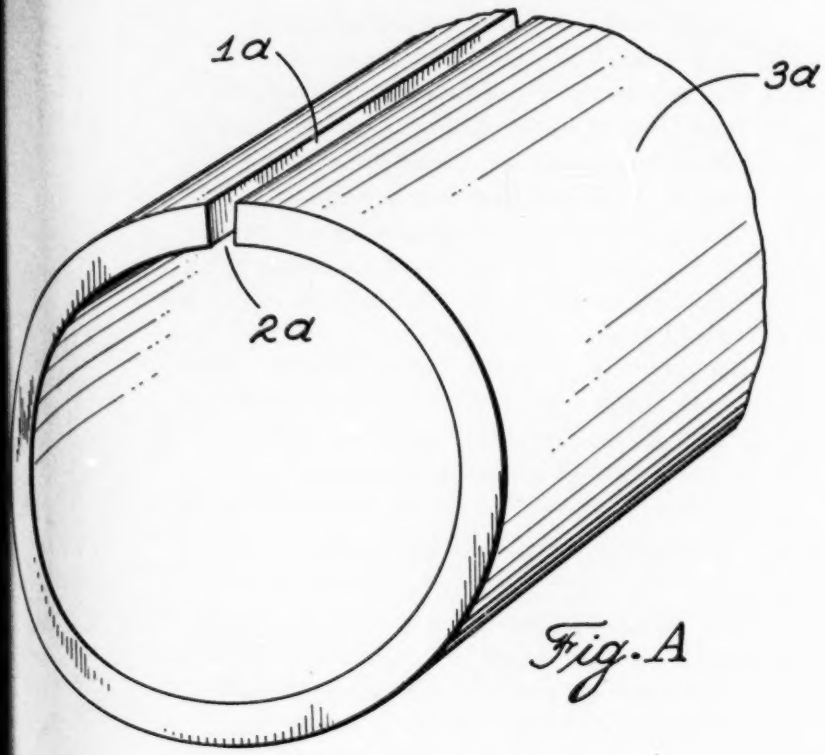


Fig. A

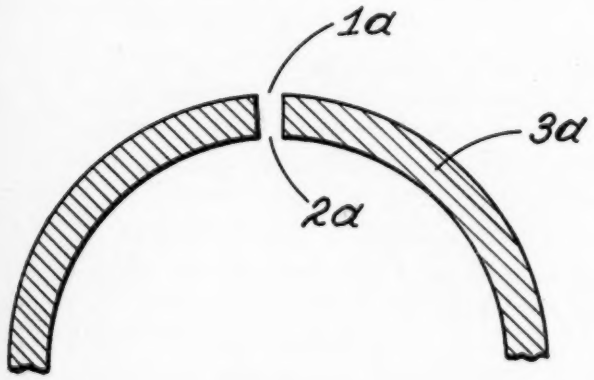


Fig. B

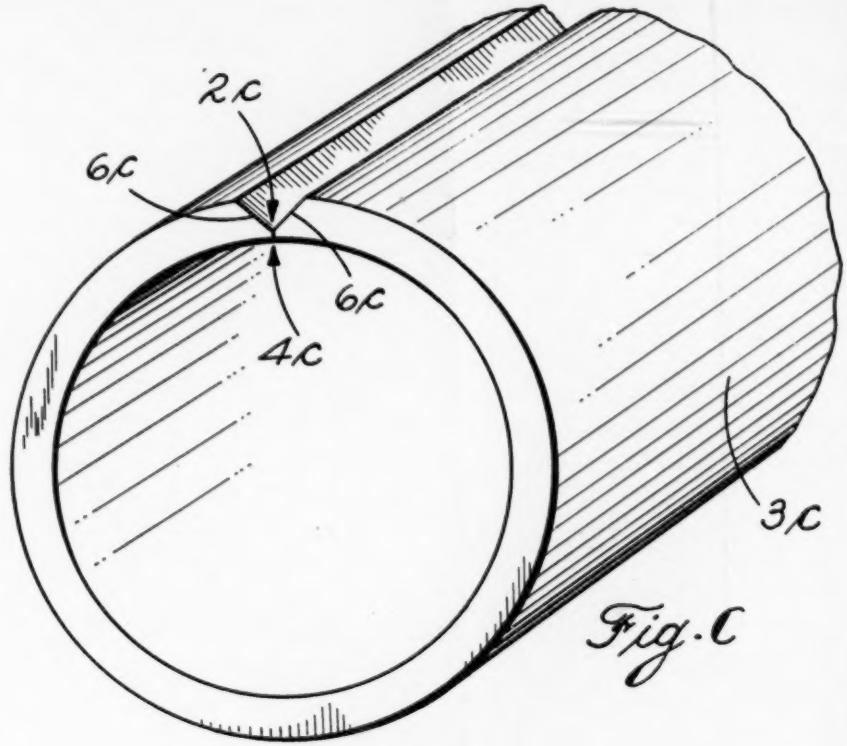


Fig. C

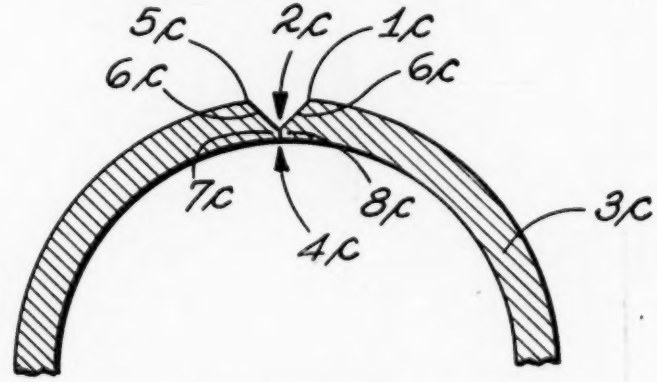


Fig. D

34). In Respondent's practice, as found by the Courts below, the edges are molten for less than the full depth as shown in Figs. C and D hereof and as is illustrated in Fig. 5 of the Catlett Patent 2,282,032 (Vol. IV, p. 1115), and a fusion weld is performed between the molten parts of the edges, just as in the case of the preferred form of the patented practice as shown in said Figs. A and B. The difference between plaintiff's preferred form and Defendant (respondent here) is, therefore, one of degree and not one of kind, as the Sixth Circuit Court of Appeals held (174 Fed. (2) 544). This difference of degree, as the same Court held, would not avoid infringement, except that the limitation to the full depth was construed erroneously, or read into the unambiguous claims in suit by that Court, as we point out hereinafter.

The inventions are defined by the claims grouped as follows:

(1) The patents contained a number of claims in suit reciting the preferred form, i.e., the seam open both at the top and bottom and the edges molten for their full depth. Such are the following: Patent 1,810,112, claims 1, 2 and 3; Patent 1,948,801, claim 8; Patent 2,139,771, claims 7 and 18, as is shown in said Figs. A and B.

(2) A second group of claims in suit refers to the open seam, but unlike the other claims does not specifically recite that the seam was open for its full depth, was open at the bottom and the top, or molten for the full depth. These claims are as follows: Claims 1, 4, 8 and 16 of Patent 2,139,771 and claims 3, 5 and 7 of Patent 1,948,801.

(3) Other claims did not recite the open seam or the molten edges at all. These are claims 16 of Patent 2,139,771, and claims 26 and 30 of Patent 2,061,671.

(4) Claims 3, 5 and 7 of patent 1,948,801 appear in a patent whose specification specifies that the invention is not limited to a seam whose edges may not be actually molten for the full depth.

This Petition is limited to the claims in Groups (2), (3) and (4).

(A) The Court of Appeals in the Sixth Circuit interpreted the claims in Groups (2) and (4) in "the light of the specification" to be limited to a seam open for its full depth and molten for the full depth.

(B) The Court of Appeals in the Sixth Circuit read the "full depth" seam and the melting for the full depth into the claims in Group (3) and held as so limited that the claims were not infringed.

The District Court made no analysis of the claims with respect to their variation in limitations in the respects discussed *supra*, or their relation to the specifications.

(B) **Reasons Relied Upon for An Allowance of the Writ:**

(1) Conflict and confusion among and between the rulings of different Circuit Courts of Appeals with regard to:

(a) the interpretation of an unambiguous patent claim "in the light of the specifications";

(b) reading features or elements not appearing in a claim into the claim "in the light of the specification."

These are questions of law (*Solomon vs. Renstrom*, 150 Fed. (2) 805, 808 (C. C. A. 8); *Baldwin vs. Paine*, 90 Fed. (2) 1, 3 (C. C. A. 6).

Wherefore, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the Court of Appeals for the Sixth Circuit, for review and determination of the judgment of said Court of Appeals.

THE MIDLAND STEEL PRODUCTS COMPANY,

By F. O. RICHEY,
H. F. MCNENNY,
Counsel for Petitioner.

In the Supreme Court of the United States

OCTOBER TERM, 1949.

No. .....

THE MIDLAND STEEL PRODUCTS COMPANY,
Petitioner,

vs.

CLARK EQUIPMENT COMPANY,
Respondent.

BRIEF IN SUPPORT OF THE PETITION FOR CERTIORARI.

STATEMENT OF THE CASE.

I.

The Opinions of the Court Below: The opinion of the Sixth Circuit Court of Appeals in the instant cause is reported at 174 Fed. (2) 541 and appears in the Supplemental Transcript of Record and Proceedings in United States Court of Appeals—Sixth Circuit, pp. 41-50 of the record.

The opinion of the District Court in the instant cause is reported at 75 Fed. Supp. 143 and appears in Vol. I, pp. 64-85 of the record.

Findings of Fact and Conclusions of Law of the District Court appear at 75 Fed. Supp. 153 and 154 and in Vol. I, pp. 85 and 86 of the record.

The decision of the Fifth Circuit Court of Appeals in *Wayne v. Humble Oil* appears at 175 Fed. (2) 230 and of *Wayne v. Texas* at 175 Fed. (2) 234.

The decision of the Fourth Circuit Court of Appeals in *Yates v. Jones* appears at 82 U. S. P. Q. 337, ... Fed. (2) .....

II.

(1) Jurisdiction of this Honorable Court is invoked under Title 28, United States Code, Section 1254.

(2) The date of the judgment below is May 31, 1949 (Proceedings in U. S. Court of Appeals—Sixth Circuit, p. 41). Petition for Rehearing was filed June 20, 1949 (Proceedings in U. S. Court of Appeals—Sixth Circuit, p. 51), and denied by the Court of Appeals on July 25, 1949 (Proceedings etc., p. 59).

(3) This suit is an Equity suit arising under the patent laws of the United States, and the judgment of the Circuit Court of Appeals for the Sixth Circuit requires that the Complaint in the suit be dismissed on the patent cause.

III.

The Issues Are:

(1) May an unambiguous claim be expanded or contracted by reference to the specification?

(2) May an unambiguous claim be expanded or contracted contrary to the specification?

(3) May an element or step which is not in an unambiguous claim be read into the claim from the specification to expand or contract the claim?

Grounds for Granting Certiorari:

(1) This Court has consistently granted Petitions for Certiorari where there was direct conflict of decisions between Circuit Courts of Appeals on particular patents or on patent principles (*Keller v. Adams-Campbell*, 264 U. S. 314; *Sontag Stores v. Nut Co.*, 310 U. S. 281; *Electric Battery v. Shimadzu*, 307 U. S. 8). All three cited cases are cases in which this Court granted Certiorari to settle differences in principle and practice in different Circuits.

Such a situation exists here, not only between two Circuits, but among various Circuits.

(2) **Industry Concentrated in a Single Circuit:** The principal and almost exclusive use of the product of the patented invention is involved in the manufacture of parts for motor cars used in the manufacture thereof, just as are aluminum pistons which were the subject-matter of the patents involved in *Schriber v. Cleveland Trust*, 305 U. S. 47. In that case this Court granted certiorari because litigation elsewhere, which might result in conflicting decisions, was improbable because of the concentration of the automobile industry in the Sixth Circuit. Precisely the same situation exists in the instant cause. The axle housings involved here are just as esoteric to the motor car industry concentrated in the Sixth Circuit as the aluminum piston was when this Court granted certiorari in *Schriber v. Cleveland Trust*. This policy has been followed by this Court since the rendition of its decision in the aluminum piston case (*MacKay v. Radio*, 306 U. S. 86, 89; *Muncie v. Outboard*, 315 U. S. 759, 766).

In *Muncie v. Outboard* this Court said (pp. 765, 766):

> "While there was no conflict of decision with respect to these claims, we granted certiorari in view of the questions presented and because the patent dominates a substantial portion of an industry so concentrated in the Seventh Circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely. 314 U. S. 594. Schriber-Schroth Co. v. Cleveland Trust Co., 305 U. S. 47."

In *Schriber v. Cleveland Trust* this Court said (p. 50):

> "We later granted certiorari, 304 U. S. 587, on a petition for rehearing showing that, notwithstanding the doubtful validity of the patents, litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit. Cf. Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U. S. 464; Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U. S. 477."

The Difference in Principle Among the Circuits relates to a Court referring to the specification of a patent to construe, to contract, or to expand an unambiguous claim in a patent.

The diversity of view is well illustrated by the resort to that practice of the Court of Appeals in the Sixth Circuit in the instant cause to construe and to contract unambiguous claims so as to put certain limitations upon them. This is illustrated by the following statement in the instant cause by the Court of Appeals (174 Fed. (2) 541 at 545-546, Proceedings, etc., p. 49):

> *"Certain of the claims, it"* (the patentee) *"urges, say nothing about the full depth of the seam or the reduction of the edges to a molten condition for their full depth, and therefore it urges that these elements may not be read into such claims.* The inventor's concept of his invention so clearly involves the spaced-apart edges and their molten condition to their full depth that *none of the claims may,* **in the light of the specifications,** *be interpreted without recognition of that concept,* and the steps in the method which are expressed in the claims, are a necessary and inescapable response to it." * (Emphasis herein ours unless otherwise indicated.)

The Court then construed and restricted the claims in Groups (2) and (3) *supra,* and held non-infringement of the claims as thus restricted.

A practice and a principle clearly contrary to the above practice in the Sixth Circuit was followed in the Fifth Circuit in the cases of *Wayne v. Humble Oil,* cited *supra,* and *Wayne v. Texas Company,* 175 Fed. (2) 234. There the

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* The inventor's concept of his invention is the combination, a legal entity separate from any element or step (*Leeds & Catlin v. Victor,* 213 U. S. 301). Therefore, a single element or step is not the concept of the invention. If it were the inventor would not have omitted it from some of his claims and stated in the specification of one of the patents in suit (1,948,801) that that element or feature said to be the concept of his invention may not be present in an embodiment of the invention.

Court refused to refer to the specification to construe a claim to contract it, saying (175 Fed. (2) 234):

> "Ambiguity in language may be cleared up by reference to the specifications, *but the claim, when unambiguous, can neither be expanded nor contracted thereby.* Graver Mfg. Co. v. Linde Air Products Co., 336 U. S. 271, 277, 69 S. Ct. 535."

In *Yates v. Jones, supra,* the Court of Appeals for the Fourth Circuit restricted unambiguous claims in the light of the specification, saying (82 U. S. P. Q. 338):

> "Thus, the claims, in the light of the specifications, must be rather narrowly construed."

Manifestly, unless this Court decides which of these antithetical practices or policies is to be followed, the confusion which now exists will continue to the great waste of the time of the Courts and the time and money of litigants. No one, of course, can reconcile these differences except this Court.

It is our contention that the policy of the Court of Appeals in the Fifth Circuit is correct and that of the Sixth Circuit in the instant cause is erroneous for the reason that a patent is a contract and the patent, or any portion thereof such as a claim, represents the final memorial of the intention of the parties, and resort may not be had to extraneous matter to interpret an unambiguous contract or an unambiguous section of a contract. This is also the rule in the English Courts. (*British, Thomson-Houston vs. Charlesworth,* 42 R. P. C. 180, 208; *Terrell on Patents* (British) pp. 121-123.)

This ancient and general rule of the law of contracts was followed by the Fifth Circuit Court of Appeals and by this Court in a patent case in *Graver v. Linde Air,* 336 U. S. 271, 277, cited by the Fifth Circuit Court of Appeals which conforms to the rule in the English Patent Courts. (*Terrell on Patents, supra.*) The rule was ignored by the Sixth Circuit Court of Appeals in several particulars, as follows:

(1) Resort was had to the specification of Patent 2,139,771 to construe into claims 1, 4, 8 and 16 a seam, and restrict these claims to a seam, open for its full depth and molten for the full depth thereof, although these features do not appear in these particular claims. (They do appear in otherwise coextensive claims in the patent, showing clearly the intention not to include them in these particular claims.) Nevertheless, the Court of Appeals referred to the specification describing the preferred form of the invention and expanded the claims to contain these limitations (174 Fed. (2) 545-546).

(2) Claims 3, 5 and 7 of Patent 1,948,801 do not recite either the opening for the full depth or the melting of the edges for the full depth. The Court of Appeals in the Sixth Circuit referred to the specification and construed these limitations into the claims though the specification says that the edges may "not be actually melted for their full depth." Thus, though presuming to follow the policy of construing unambiguous claims in the light of the specification, the Court construed them contrary to the specification.

(3) Claim 16 of Patent 2,139,771 and claims 26 and 30 of Patent 2,601,671 do not recite the open seam or the molten edges at all. The Court of Appeals of the Sixth Circuit, therefore, bodily read these features into these three claims from the specification.

When such confusion in principle or policy exists between or among the Circuit Courts of Appeals as we have shown above, the deleterious effects are of far greater compass than where the differences relate to a confusion in view regarding a particular patent, a condition which has universally resulted in certiorari by this Court (*G. E. vs. Wabash*, 304 U. S. 364; *Textile vs. Hirsch*, 302 U. S. 490; *Mumm v. Decker*, 301 U. S. 168).

The Claim, and Not the Claim as Modified by the Specification, Measures the Grant, as this Court has frequently held (see, for example, *Milcor Steel v. Fuller,* 316 U. S. 143, 145; *General Electric v. Wabash,* 304 U. S. 364, 369; *Altoona v. Tri-Ergon Corp.,* 294 U. S. 477, 487. There would be little purpose in such holdings if unambiguous claims could be construed to include a part of the specification for then it would not be the claim which measured the grant, but the claim as modified "in the light of the specification." Moreover, there would be little reason for requiring the claims to be separately written if they are not to be separately read. If a claim which is written separately from the specification were read "in the light of the specification," it would not then be read separately from the specification.

We do not mean here to say that resort might not be had to the specification to construe an ambiguous claim. The claims here are not ambiguous. There is no evidence and no finding that any claim involved is ambiguous. But, even where the claim is ambiguous, reference to the specification may be had only for purposes of construction and not to read an element or feature into or out of a claim (*McCarty v..Lehigh,* 160 U. S. 110, 116) and not to construe an element or feature into a claim so as to make it coextensive, or substantially coextensive, with some other claim. (*Mast v. Dempster,* 82 Fed. 327, 333 (CCA 8); *Lamson v. Hillman,* 123 Fed. 416, 419 (CCA 7)). In the latter case the fact that the claims differ show that it was the intent of the constructor of the claims that they should be read as they are written and such presumption overcomes any construction that might be placed upon an ambiguous claim by reference to a specification to make it coextensive with the other claim.

In the instant cause, however, as we have said, not only are the claims unambiguous, but to construe them as the Court of Appeals for the Sixth Circuit did "in the light of the specification" would be to make them coextensive with

other claims so that not only has the cardinal rule that an unambiguous claim measures the grant and must be read separately from the specification been violated, but the rule that a claim, whether ambiguous or unambiguous, may not be construed "in the light of the specification" to make it coextensive with other claims in the patent has also been violated.

Deleterious Results of This Confusion: In view of the instant conflict lawyers cannot know how to advise clients regarding the scope of claims, or how that scope may be affected by the specification, if at all. Attorneys do not know what the attitudes of particular Courts in the several Circuits will be upon these subjects though, in the confidence that the Courts in a certain Circuit will follow a policy most favorable to a particular patent claim, the parties will not only maneuver to secure, or not to secure, the jurisdiction of the Court that seems most favorable, but since the passage of the Transfer Statute (Title 28, U. S. C., Sec. 1404(a))* Motions and other efforts will be made to transfer a cause from what seems to be an unfavorable jurisdiction to a favorable jurisdiction. All of this not only causes great expense to litigants, but great annoyance, and places great burdens upon the Courts. There was every reason to reconcile such differences as exist in the cause at bar even before the passage of this Transfer Statute, but the enactment thereof makes the reason for settling these matters all the more important, not only in the interests of the parties, but in the interests of the Courts themselves.

Indeed, the expense and work caused by such confusions go a long way toward reducing, and in some cases makes a mockery, of the reward promised the inventor by Congress and the Constitution under the patent laws.

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* "Title 28, Section 1404. Change of Venue.

(a) For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought."

While the purposes of most laws are to settle controversies without breach of the peace, the purpose of the patent laws is to encourage invention by rewarding the inventor with a patent. It is important, therefore, not to negative the reward and the purpose of the laws by leaving the administration of the laws in such confusion that the burden of adjudicating a patent will outweigh the advantages of the patent reward and the patentee will have lost by his invention instead of gaining thereby, as was intended by Congress and the Constitution even when, and if the judgment is in his favor.

Your Petitioner, therefore, prays that this Court will reconcile these differences and prevent these confusions from proceeding further or arising in the future.

Respectfully submitted,

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